



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,974	05/23/2001	Robert J. Gartside	1094-10	1412
7590 04/21/2004				
Peter G. Dilworth DILWORTH & BARRESE, LLP 333 Earle Ovington Blvd. Uniondale, NY 11553			EXAMINER HENDRICKSON, STUART L	
			ART UNIT 1754	PAPER NUMBER

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/863974

Applicant(s)

Gertside

Examiner

Hicks

Group Art Unit

1751

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

☒ Responsive to communication(s) filed on 4/12/04

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-12, 22-25 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-12, 22-25 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1754

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 10-12, 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sun 4778943.

Sun teaches in column 4 MgO catalyst. Where the examiner has found a substantially similar product as in the applied prior art the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324.

Claims 10-12, 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lowery et al 5153165.

Lowery teaches in column 5 MgO for double-bond isomerization, activated under nitrogen. No differences are seen versus the claimed catalysts. See *In re Brown* and *In re Fessmann*, *supra*.

Claims 10-12, 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lowery et al. 5134103.

Lowery teaches in column 8 treating MgO catalyst in dry nitrogen. See *In re Brown* and *In re Fessmann*, *supra*.

Claims 1-7, 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowery '103 taken with Schaub 5077029.

Lowery does not teach how the nitrogen was made or its oxygen content, however Schaub teaches an essentially pure nitrogen in column 2. Using this in the process of Lowery is an obvious expedient to provide the dry, pure nitrogen used by Lowery. See *In re Kamlet* 88 USPQ 106. Although the conditions of claim 5 are more severe than those of Lowery, using the

Art Unit: 1754

claimed longer time and higher temperature is an obvious expedient to assure completion and effectiveness of the treatment.

Claims 8, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowery '103 taken with Schaub as applied to claims 1-7, 22-25 above, and further in view of Low et al. 5003118 and Didillon.

The above references do not teach treating to remove coke, however Low teaches in column 4 that coking is a problem in isomerization systems similar to those of Lowery. Didillon teaches the claimed steps of removing coke; the discussion in paper of 1/2/03 is incorporated herein. Using these steps is an obvious expedient to keep the catalyst effective for a long time.

Applicant's arguments filed 4/12/04 have been fully considered but they are not persuasive.

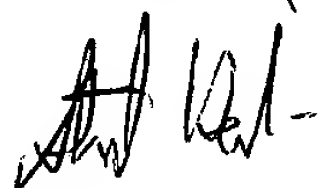
No difference between prior art 'MgO' and claimed 'MgO' has been shown, and do not differ in composition. Sun does not have to treat the MgO to make it acidic- see ex. 6. The claims do not reflect whatever difference exists in the catalyst after the claimed treatment. The inert support of '165 and binder of '103 are not seen to materially affect the composition, and thus is not excluded. Since the claims recite 'basic' material, it is not seen why trace Mg hydroxide are excluded- notwithstanding the fact that '103 teaches 'MgO'. Regarding claim 1 a) '103 teaches 'activating' b) the claims do not require activating (only activating 'conditions') and c) the treatment is essentially the same, so the name given to it is not material. '103 teaches dry nitrogen, implicitly treated to be dry. Therefore, the combination is proper. Low and Didillon are material because they teach features which are claimed. The intended use does not limit a catalyst and applicant has not shown why the prior art materials 'cannot' be used. Specification pg. 11 is incomplete.

Art Unit: 1754

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (571) 272-1351.

A handwritten signature in black ink, appearing to read 'Stuart Hendrickson', is positioned above the printed name.

Stuart Hendrickson  
examiner Art Unit 1754